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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Weiss *et al.*
Serial No. : 08/486,313
Filed : June 7, 1995
For: MULTIPOTENT NEURAL STEM CELL COMPOSITIONS
Examiner : A-M. Baker
Group Art Unit : 1632

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P.2.

Box AF

Assistant Commissioner for Patents
Washington, D.C. 20231

Boston, Massachusetts
July 30, 2001

RESPONSE AFTER FINAL

This paper is in response to the January 31, 2001, Final Office Action in the above-identified application. Applicants submit herewith a Petition for a three (3) Month Extension of Time and the appropriate fee under 37 C.F.R. § 1.17(a)(3). Applicants also submit herewith a Notice of Appeal and the accompanying fee under 37 C.F.R. § 1.17(b).

Applicants believe that no additional fee is due with this response. However, should any additional fee be due, the Commissioner is hereby authorized to charge the same, or credit any overpayment, to Deposit Account No. 50-0311 (Reference 17810-705; CTI-N5 DIV12).

REMARKS

Claims 26-27, 32-37, and 39-62, directed to methods of transplanting neural stem cell progeny, are pending in this application. There is a sole remaining rejection under 35 U.S.C. § 112, first paragraph for lack of enablement. According to the Examiner, "[t]he claims are not enabled because the transplantation of multipotent neural stem cell progeny into a host has not been demonstrated to provide any therapeutic benefit to the host" (Office Action at page 3). Thus the Examiner has argued that the specification fails to teach "how to use" requirement of 35 U.S.C. § 112, first paragraph. This rejection should be withdrawn.

First, the rejection is improperly made under § 112, first paragraph. Where, as here, the Examiner has questioned the therapeutic efficacy or benefit, the rejection is properly the subject of a § 101 utility rejection (with a concurrent § 112 first paragraph rejection) on the basis that the